

Remarks

Claims 1-39 are currently pending in this application. The Office has stated, as its sole basis for rejection, that Applicant's claims are not limited to tangible embodiments as required by 35 U.S.C. § 101 and "new Office Guidelines." This is a non-final Office action and is responsive to Applicant's Appeal brief filed on or before February 6, 2006. The Office terminated Applicant's Appeal and reopened prosecution.

The 101 Rejection of Claims 1-39

The Office has rejected all claims under 35 U.S.C. § 101 asserting that "the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is useful, tangible and concrete." (Office action, page 3. In addition, the Office cites as support *State Street*, 149, F.3d at 1373-74 USPQ2d at 1601-02.) Applicant disagrees. The Court stated in *State Street* that "the transformation of data ... by a machine through a series of mathematical calculations ... constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result'." A person of ordinary skill in the art would appreciate that Applicant's claimed invention comprises one or more practical applications each comprising a transformation of data that satisfies the requirements set forth by the Court and by statute. For example, Applicant's claimed invention performs a database "join" operation which clearly transforms data and produces a useful, concrete and tangible result. Thus, Applicant's claims are drawn to statutory subject matter and the rejection by the Office is improper.

The Office has requested that Applicant amend the claims to include the following: "What is the practical application? What is the result? What is [the] final result that is concrete, useful and tangible?" (Office action, page 4.) Applicant declines the Office's invitation to amend the claims. Furthermore, Applicant believes claims 1-39, as currently drafted, contains proper limitations that adhere to both court and statutory

requirements. Independent claims 1, 24, and 33 undoubtedly contain a practical application, e.g., a computer implemented database system and tangible results (e.g., the processing of a database join). It would be clear to one of ordinary skill in the art that the “practical application, result, concrete, useful and tangible limitations” (Office Action, page 4) required by the Office are currently present in the claims. Therefore, no amendments are necessary and the Office's rejection of claims 1-39 is improper. Applicant's claims are allowable over the current rejection.

The Office further asserts that “claims 1-39 are not limited to tangible embodiments. In view of Applicant’s disclosure, specification pages [0082], the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments and intangible embodiments (e.g., [carrier wave]).” (Office action, page 4.) Applicant again disagrees. Applicant is at a lost to understand how a paragraph from the specification, that describes different methods of transporting software to a computer system, provides the Office with proper grounds for a 101 rejection of limitations found in claims 1-39. It appears that the Office has examined the specification and not the claims. In any case, Applicant disagrees with the Office’s assertion that transferring software over a network such as Ethernet, which uses a carrier wave to transmit data, is an intangible embodiment that would render a claim unpatentable due to non-statutory subject matter. Additionally, the Office has stated “to overcome this type of 101 rejection the claims need to be amended to include only physical computer media” (Office action, page 4.) The Office appears to have improperly interpreted the courts use of the term “concrete, useful and tangible” to mean claims can contain only elements that can be literally seen or touched, such as the physical computer media suggested by the Office. This is an improper interpretation by the Office. Furthermore, since the Office has failed to point out any limitation within any claim that is drawn from this teaching, the Office, by implication, is asserting that the mere presence of this teaching within the specification is sufficient grounds to render all claims unpatentable under 35 U.S.C. § 101 whether or not the claims contain such a limitation. This is also an improper application of the statute and Court rulings. Lastly, even if one or more claims did

contain elements of the above embodiment, the presence of such elements does not in and of itself render a claim unpatentable under 35 U.S.C. § 101 due to non-statutory subject matter. The Court in *State Street* said “it is irrelevant that a claim may contain, as part of the whole, subject matter which would not be patentable by itself.” Thus, even if the above embodiment is unpatentable (a position Applicant does not support), its presence is irrelevant to a 35 U.S.C. § 101 rejection. Therefore, the suggestion to amend the claims is improper as is the Office’s examination and rejection of the claims.

Conclusions

The rejection of claims 1-39 is improper. The Office has failed to particularly point out and describe limitations contained within the claims that do not meet the statutory requirements of and the judicial precedent for 35 U.S.C. § 101. Furthermore, since the Office pulled this application from appeal and has declined to use this opportunity to show any additional basis for rejecting the claims, Applicant must assume that the Office admits there is no additional prior art and that the claims are allowable over the prior art of record. Therefore, since the current rejection is improper and all other rejections have been overcome or withdrawn from consideration, Applicant requests that the claims be allowed.

Respectfully submitted,

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